

REMARKS

The present amendment is in response to the Official Action dated May 30, 2006, where the Examiner rejected pending claims 1-39. More specifically, the Examiner rejected claims 1, 15 and 22 under 35 USC 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter the applicant regards as the invention, focusing on terms “relatively” and “substantially” as rendering the claim indefinite. The Examiner has further provisionally rejected claims 1-39 on the alleged grounds of nonstatutory obviousness type double patenting, in view of claims 1-23 of copending US Patent Application No. 10/331,294. However contrary to the Examiner’s allegations, the claims of the present application are not made indefinite through the use of the terms “relatively” and “substantially”, nor do the claims of the present application constitute an attempt to double patent, where the claims are directed to separate inventions, which are non-obvious relative to one another.

Regarding the alleged indefiniteness, contrary to the Examiner’s assertions, the term “substantially” is quite common in claims, and in and of themselves generally do not render a claim indefinite. It is specifically noted, that the term has been the subject of several litigation matters, during which time the courts have had an opportunity to comment. In fact the Federal Circuit has stated that “[c]laims need only ‘reasonably apprise those skilled in the art’ as to their scope to satisfy the definiteness requirement ... In addition, the use of modifiers in the claim, like ‘generally’ and ‘substantial,’ does not by itself render the claim indefinite.” Energy Absorption Sys., Inc. v. Roadway Safety Servs., Inc., Civ. App. 96-1264 (Fed. Cir. July 3, 1997) (unpublished) (citing Hybritech v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 828-29, 221 USPQ 568, 575-76 (Fed. Cir. 1984)).

Furthermore searching the claims of issued patents from 1976 to the present, on the US Patent and Trademark Office Web Site, has identified at least 5005 issued patents, which use the phrase “substantially closed”. An example of one of the more recently issued patents includes Majercak et al., US Patent No. 7,070,616, (see claim 25). This claim is particularly relevant in that it expressly claims a movement between a substantially open and a substantially closed position. The phrase “substantially opened” has been identified as being present in at least 62 issued patents (1976 – present), and increases to at least 2068 patents, when one alternatively looks for the phrase “substantially open”. The phrase “substantially perpendicular” has been

identified as being present in at least 50,354 issued patents (1976 – present). The rather prolific use of the not just the term substantially, but the term used in conjunction with the term being modified strongly suggests, that one skilled in the art is well equipped to determine the scope of a claim incorporating such language making the same sufficiently definite.

Regarding the phrases “relatively fixed” and “relatively free” they serve to distinguish between two ends of a tension device, where one end is largely constrained to limit movement, and the other end is largely allowed to move more freely. For example, in the embodiment illustrated in FIGS. 3-5, the relatively fixed end is oriented to rest against a wall, where the relatively fixed end is generally constrained relative to the upper housing, which includes the respective wall. The other end is allowed to move more freely when viewed from the point of view of the upper housing, and thereby contribute to the movement of other elements. In a further embodiment, illustrated in FIGS. 6-11, the relatively fixed end is largely captivated within a depression 123 (see FIG. 6). The claims have been amended, in an attempt to make the same more clear.

In view of the present explanation and corresponding amendments, the claims are believed to avoid the Examiner’s concerns relative to any assertion directed to a lack of distinctiveness. The applicants would respectfully request that the Examiner reconsider the objection in view of the present response.

Regarding the alleged double patenting, the same is believed to be misapplied, as the Examiner has failed to establish a prima facie case of double patenting. A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). The analysis of a double patenting rejection of the obviousness-type has largely been similar to the guidelines for analysis of a 35 USC 103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289, 1292 (Fed Cir. 1991). As a result, the MPEP §804(II)(B)(1) has indicated:

Any obvious-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application ; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

However in each instance the Examiner has failed to present a plausible reason why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

In fact the Examiner has acknowledged that the claims are not identical, but relies upon the fact that claims in one application are broader than the claims in the other application. Claims from an application having an earlier priority date are entitled to be broader, but a broader claim does not necessarily imply that all subsequently developed innovations directed to additional features beyond those disclosed or claimed in the filing having the earlier priority date are in fact obvious.

While the Examiner briefly notes the mechanical stop as representing a difference between the two sets of claims, the Examiner provides no further analysis to justify the finding of that this represents an obvious variation of the invention defined in the other application. The Examiner has further ignored other difference including the differences between how the tension devices are employed, where in the case of copending US Application Serial No. 10/331,294, one end of the tension device is coupled to a first housing element and a second end that is coupled to the second housing element at a point which travels around the axis of rotation along said path of the first housing element. The Examiner has not attempted to show how such a configuration would be obvious in view of the teachings of the present application, or how the same represents an obvious variation of what is being claimed in the present application. Consequently, until such time that the Examiner presents a prima facie case of double patenting, the applicants have no obligation to even respond. However having responded, the examiner is not only still required to present a prima facie showing, but is further tasked with addressing the above noted remarks arguing against the applicability of any such rejection based upon an alleged double patenting. Consequently, any suggestion that the claims of the present application represent an attempt to double patent in view of copending US Application Serial No. 10/331,294, as presently formulated is without merit.

In view of the present response, the applicants would respectfully request that the Examiner reexamine and reconsider the presently pending claims, where the claims as presently pending are believed to be allowable over the present rejections.

Respectfully submitted,

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